

invention was made to a person having ordinary skill in the pertinent art.²⁸ Obviousness under 35 U.S.C. § 103 is a legal conclusion based on underlying factual determinations.²⁹ The underlying factual determinations include (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the claimed invention and the prior art, and (4) objective indicia of non-obviousness.³⁰

The Federal Circuit has stated that to reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness.³¹ To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.³² “All words in a claim must be considered in judging the patentability of that claim against the prior art.”³³

“What the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references are questions of fact.”³⁴ The Supreme Court reaffirmed the requirement that an obviousness analysis should be made explicit to facilitate review.³⁵ “Every case, particularly those raising the issue of obviousness under section 103, must necessarily be decided upon its own facts.”³⁶ “The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”³⁷ In this regard, maintaining objectivity in the obviousness inquiry is accomplished by resolving the level of ordinary skill in the art.³⁸

A prior art reference that “teaches away” from a given combination may negate a motivation to modify the prior art to meet the claimed invention.³⁹ “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be

²⁸ 35 U.S.C. § 103(a) (2000).

²⁹ *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164, 77 U.S.P.Q.2d 1865, 1869 (Fed. Cir. 2006).

³⁰ *KSR Intern. Co. v. Teleflex Inc.*, --- U.S. ----, 2007 WL 1237837, *12 (2007), citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

³¹ *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

³² *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

³³ *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

³⁴ *In re Fulton*, 391 F.3d 1195, 1199-1200, 73 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 2004).

³⁵ *KSR Intern. Co. v. Teleflex Inc.*, --- U.S. ----, 2007 WL 1237837, *13 (2007), *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

³⁶ *In re Jones*, 958 F.2d 347, 350, 21 U.S.P.Q.2d 1941, 1943 (Fed. Cir. 1992).

³⁷ *Interconnect Planning Co. v. Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547 (Fed. Cir. 1985).

³⁸ *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 U.S.P.Q.2d 1053, 1057 (Fed. Cir. 1991).

³⁹ See *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165, 77 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2006).